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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appl. No. : 10/624,752 Confirmation No. 6482
Appellant : Leonard M. Walsh
Filed : July 22, 2003
TC/A.U. : 3721
Examiner : Scott A. Smith

Docket No. : EH-10667(04-625)
Customer No. : 52237

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

APPEAL BRIEF

Sir:

This is an appeal to the Board of Patent Appeals and Interferences from the final rejection of claims 1 - 3, 5 - 9. 11 - 15, and 17 -20, dated October 19, 2005, made by the Primary Examiner in Tech Center/Art Unit 3721.

REAL PARTY IN INTEREST

The real party in interest is United Technologies Corporation of Hartford, Connecticut.

RELATED APPEALS AND INTERFERENCES

There are no other prior and pending appeals, interferences or judicial proceedings known to Appellant, Appellant's legal representative, or Assignee which may be related to, directly affect, or be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1 - 3, 5 - 9, 11 - 15 and 17 - 20 pending in the application and are on appeal. Appendix A contains the claims on appeal.

Claims 4, 10, 16, and 21 - 26 have been cancelled from the application.

STATUS OF AMENDMENTS

No amendment was filed subsequent to the final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

The claims on appeal relate to an ergonomic impact tool which isolates impact forces from a user. (See page 2, paragraph 0009 and page 3, paragraph 0010 of the specification.) The impact tool may be used in the disassembly of an industrial gas turbine during an overhaul.

The tool (50), as set forth in claim 1, comprises a shaft (51), a stop (53) on the shaft, a slider (57) movable on the shaft for striking the stop to create an impact force, and a handle (59) on the slider which allows the user to move the slider. The handle has two legs (61, 63) extending from the slider and a central section (65) extending between and joined to the legs. (See page 6, paragraphs 0029 - 0031 of the specification and FIG. 2 of the drawings.) A first one of the legs is connected to a first side of the slider and the second one of the legs is connected to a second side of the slider. (See paragraph 0032 in the specification and FIG. 2) The handle is movably attached to the slider so that the handle moves relative to the slider when the slider strikes the stop to isolate the handle from the impact force. (See FIGS. 3 and 4).

The handle (59) is rotatably attached to the slider (57). (See paragraph 0032 of the specification.) As set forth in claim 5, the user can grasp the handle with the wrist in the normal position. (See paragraph 0031 on page 6 of the specification). Still further, as set forth in claim 6, the handle (59) forms a gripping section located a distance away from the slider (57). (See paragraph 0034 on page 7 of the specification.)

The slider (57) moves along the shaft (51) in a direction (see FIG. 2) and the gripping section extends transverse to the direction.

As set forth in claim 8, the handle is movable relative to the slider from a first position in proximity to a first end of the slider (see FIG. 3) to a second position in proximity to said second end when said slider strikes the stop (see FIG. 4). (Also see page 7, paragraphs 0036 and 0037 of the specification.)

The claimed invention also relates to a slider (57) for an impact tool. The slider comprises a sleeve (see page 6, paragraph 0029 of the specification and FIG. 2) and a handle (59) movably attached to the sleeve to allow a user to move the slider. The handle is formed by a first leg (61) joined to a first side of the sleeve, a second leg (63) joined to a second side of the sleeve, and a central section (65) extending between and joined to the first and second legs. (See paragraph 0031 on page 6 of the specification.) The handle moves relative to the slider in a direction parallel to a longitudinal axis of the sleeve when the slider strikes a stop on the impact tool to isolate the handle from a force created by the slider striking the stop. (See FIGS. 2 - 4 of the drawings).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed on appeal are as follows:

(1) claims 8, 9, 11 - 15 and 17 - 20 under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement;

(2) the rejection of claims 8, 9, 11 - 15 and 17 - 20 under 35 U.S.C. 112, second paragraph;

(3) the rejection of claims 1, 2, 5, 6, 8, 11, 12, 14, 17 and 18 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,088,174 to Hull et al.;

(4) the rejection of claims 3, 7, 9, 13, 15, 19, and 20 under 35 U.S.C. 103(a) as being unpatentable over Hull et al. in view of U.S. Patent No. 5,398,773 to Baker or U.S. Patent No. 5,845,719 to Matsumoto et al.; and

(5) the rejection of claims 8, 9, and 13 - 20 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,323,519 to Cloud in view of Baker or Matsumoto et al.

ARGUMENT

(a) Claims 8, 9, 11 - 15, and 17 - 20 Complies With the Written Description Requirement of 35 U.S.C., 1st Paragraph

The function of the written description requirement is to ensure that the inventor had possession, as of the filing date of the application, of the specific subject matter later claimed by him. See *In re Wertheim*, 541 F.2d 257, 262 (CCPA 1976). The test for determining compliance with the written description requirement is whether the disclosure of the *application* as originally filed reasonably conveys to the artisan that the inventor had possession of the later claimed subject matter at

the time of filing of the application, rather than the presence of absence of literal support in the specification for the claim language. See *In re Kaslow,* 707 F.2d 1366, 1375 (Fed. Cir. 1983).

The Examiner contends that the specification does not describe that the handle is movable from a first position in proximity to a first end and a second position in proximity to a second end of the slider when the slider strikes the stop. The Examiner contends that the specification fails to disclose that the handle is proximal to a first and second end specifically during operation, especially when the slider strikes the stop. The Examiner contends that the specification merely states that the handle rotates along a path R during use. The Examiner's contentions are wrong.

In conducting his analysis, the Examiner ignores the fact that the originally filed specification also includes drawings. The specification as originally filed clearly discloses and shows the slider (57) as moving along the direction T (see paragraph 0029 of the application and FIGS. 2 - 4). Since the handle is attached to the slider, it follows that the handle moves along the direction T in addition to rotating along the path R. If the handle did not do this, the device would not operate.

Further, it is clear from FIG. 3 that the handle assumes a first position in proximity to a first end of the slider. It is also clear from FIG. 4 that the handle has moved to a second position in proximity to a second end of the slider (57) when the slider strikes the stop (53). That is all that is being claimed in claim 8. Thus, the original drawings, as well as the description, fully support the phrase "said handle being moveable relative to said slider from a first position in

proximity to said first end *to* (emphasis) a second position in proximity to said second end when said slider strikes the stop." The error in the Examiner's position is that he is ignoring the law set forth in the *Kaslow* case - namely that there does not have to be literal support in the specification for the claim language.

With regard to the Examiner's interpretation of the language, such interpretation is not relevant to the issue of compliance with the written description requirement. All that matters is that the language of claim reads on what is occurring in FIGS. 2 and 3.

With regard to the Examiner contention that there is no disclosure for the limitation in claims 14 and 20 that the handle moves in a direction parallel to a longitudinal axis of the sleeve, this contention is also wrong. The Examiner fails to consider that movement along an arcuate path has a horizontal component to the movement (parallel to the slider) as well as a vertical component to the movement (movement towards and away from the slider). Appellant submits that the horizontal component of the movement of the handle (59) is movement in a direction parallel to the sleeve's longitudinal axis. If the handle did not move in a direction parallel to the longitudinal axis of the sleeve, it could not move from the position in proximity to a first end of the slider (FIG. 3) to a position in proximity to a second end of the slider (FIG. 4). Further, the Examiner fails to note that a path has a direction. In this case, the direction of the path is parallel to the longitudinal axis of the sleeve. Again, the specification does not need to have literal support for the claimed language.

As can be seen from the foregoing discussion, the originally filed specification described the claimed subject

matter in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

(b) Claims 8, 9, 11 - 15, and 17 - 20 Are Definite Under 35 U.S.C. 112, second paragraph

A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographer. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art. Applicants may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought. Appellant submits that the "objected to" language does not use terms in a way contrary to the accepted meaning in the art.

In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the Examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph. See *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000).

In Appellant's opinion, the rejection of claims 8, 9, 11 - 15, and 17 - 20 on indefiniteness grounds is deficient in that the Examiner has not pointed out anything in the claims that cannot be understood from a review of the specification and the drawings. It is clear to Appellant that the Examiner is reading the claim as saying that the handle only moves from the claimed first position to the second position when the slider strikes the stop. *This is not what the claim is saying*. The claim clearly states that the handle is moveable from a first position in proximity to said first end *to* (emphasis added) a second position in proximity to said second end when said slider strikes said stop. The claim language does nothing more than describe the position of the handle shown in FIG. 3 and the position of the handle in FIG. 4. There is nothing confusing about the claim language when it is read in light of the description and in light of the drawings. The Examiner's interpretation of the "objected to" language is irrelevant because the Examiner is not reading the claim in light of the specification. As for claims 14 and 20, as noted above, which discussion is incorporated by reference herein, even an arcuate path has a direction. In this case, the handle, as it moves along the path R, moves relative to the slider along an axis parallel to the longitudinal axis of the slider as the user moves the slider towards and away from the stop. The axis is nothing more than the horizontal component of the arcuate path which is also the direction of the path.

For these reasons, one of ordinary skill in the art would clearly understand the meaning of the claim terminology as well as its scope. Therefore, the claim serves the notice function required by 35 U.S.C. 112, second paragraph.

(c) Patentability of Independent Claim 1

Over Hull et al.

It is well settled law that in order for a reference to anticipate a claim, each and every limitation of the claimed invention must be found in a single prior art reference. See *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 USPQ2d 1766 (Fed. Cir. 1987).

Claim 1 calls for the impact tool to have a shaft, a stop on the shaft, a slider which moves along the shaft and a handle which has a first leg and a second leg, and a central section extending between and joined to the first and second legs. The claim calls for "a first one of said legs being connected to a first side of said slider and a second one of said legs being connected to a second side of said slider." It is clear that the Hull et al. patent relied upon by the Examiner has a pair of handles. See FIG. 3 of Hull et al. However, unlike the claimed invention, while each handle has first and second legs, both legs are joined to the same side of the slider. With regard to the Examiner's interpretation of "a first side" and "a second side", the ends may be sides; however, neither of Hull et al.'s handles are connected to two opposed ends. Thus, every limitation of the invention set forth in claim 1 is not to be found in the Hull et al. patent. Hence, Hull et al. does not anticipate the subject matter of claim 1.

(d) *Patentability of Claims 2, 5, and 6*

Over Hull et al.

Claims 2, 5, and 6 are allowable for the same reason as claim 1 as well as on their own accord.

(e) *Patentability of Independent Claim 8 over Hull et al.*

Claim 8 calls for the impact tool to have a shaft, a stop on the shaft, a slider movable on the shaft for striking the stop to create an impact force, which slider has a first end and a second end, and a handle movably attached to the slider to allow a user to move the slider. The claim goes onto say that the handle is "moveable relative to the slider from a first position in proximity to the first end to a second position in proximity to the second end when the slider strikes the stop." The claim also goes on to say that the handle has a first leg joined to the slider, a second leg joined to the slider, and a central section extending between and joined to the first and second legs.

It is submitted that the subject matter of claim 8 is not anticipated by Hull et al. Hull et al. lacks a handle which is movable in the manner described in the claim. There is no handle in Hull et al. which moves relative to the slider from a first position in proximity to said first end to a second position in proximity to a second end when said slider strikes the stop. Since Hull et al. does not have each and every limitation set forth in claim 8, it can not anticipate the claim under section 102(b).

(f) *Patentability of Claims 11 and 12 Over Hull et al.*

Claims 11 - 12 are allowable for the same reasons as claim 8 as well as on their own accord.

(g) *Patentability of Independent Claim 14 Over Hull et al.*

Claim 14 calls for a slider for an impact tool, comprising a sleeve, and a handle movably attached to the sleeve to allow a user to move the slider.

The handle is formed by a first leg joined to a first side of the sleeve, a second leg joined to a second side of the sleeve, and a central section extending between and being joined to the first and second legs. The claim further calls for the handle to move relative to the slider in a direction parallel to a longitudinal axis of the sleeve when the slider strikes a stop on the impact tool to isolate the handle from a force created by the slider striking the stop.

It is clear that the Hull et al. patent relied upon by the Examiner has a slider with a pair of handles. See FIG. 3 of Hull et al. However, unlike the claimed invention, while each handle has first and second legs, both legs are joined to the same side of the slider. Thus, every limitation of the invention set forth in claim 14 is not to be found in the Hull et al. patent. Hence, Hull et al. does not anticipate the subject matter of claim 14.

(h) *Patentability of Claims 17 and 18 Over Hull et al.*

Claims 17 - 18 are allowable for the same reasons as claim 14 as well as on their own accord.

(i) *Patentability of Claims 3, 7, 9, 13, 15, 19 over Hull et al. in view of Baker or Matsumoto et al.*

Claims 3, 9, and 15 all call for the handle to be rotatably attached to the slider. Clearly, in Hull et al., neither handle is rotatably attached to the slider. Recognizing this deficiency, the Examiner cites Baker and Matsumoto et al. as

disclosing an impact tool comprising a handle including leg portions and a gripping portion rotatable relative to a body or slider during tool impact, wherein the gripping portion is transverse to a longitudinal axis of the body or slider. The Examiner concludes that it would have been obvious to one skilled in the art to provide Hull et al. with a movable handle which rotates and is oriented as claimed in order to allow for an alternate handle grasping orientation and since to do [so] provides no new and unexpected results.

The proposed combination of references fails for the following reasons. In the claimed invention, the rotatable handle is needed to facilitate the pulling of the slider between its end positions. Hull et al. accomplishes the same exact result using two handles fixed to the slider. The question then becomes what would motivate one of ordinary skill in the art to substitute a rotatable handle in lieu of Hull et al.'s fixed handles. Certainly, there is nothing in the Baker or Matsumoto et al. patents which would motivate such a modification.

The Baker patent is directed to an access tool which is smashed against a door or the like. It lacks any slider mounted on a shaft and a rotatable handle mounted to the slider. The only rotatable handle disclosed in the Baker patent is the hoist handle (20) which is attached to an outer surface (15) of an outer cylinder (11) by a bolt-nut combination. Certainly, there is nothing in Baker which would teach or suggest that one could facilitate the movement of a slider on a shaft by using a rotatable handle since there is no slider in Baker. In fact, one of ordinary skill in the art would be dissuaded from using the handle in Baker because the handle is mounted on a bolt (21) which passes through the cylinder (11). One could not use such an arrangement in the Hull et al. device because a bolt passing

through the slider would preclude and impair movement of the slider relative to the shaft. Thus, one of ordinary skill in the art would not be motivated to make the combination. See *In re Gordon,* 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The Matsumoto patent is from non-analogous art. The Matsumoto patent relates to a portable manually operated apparatus for cutting turf which has two control handles (19) fixed to a motor body by handle fixing knobs (20). Each handle is separately adjustable. A balance band (21) is provided to enable the operator to maintain the balance of the machine. The vibrating cutting-machine of this invention is used by holding the cutting handles (19), standing the main body (1) perpendicularly on the field of a golf course and placing the lower edge (16a) of the cutting depth adjusting member (16) on the turf (13) to be cut. Clearly, there is no slider in Matsumoto whose movement is caused by the handles (19). Appellant submits that because of the diverse nature of Matsumoto et al., it would not suggest, teach or motivate one of ordinary skill in the art to replace the fixed handles on the slider of Hull et al. by the rotatable handles of Matsumoto.

It is submitted that claims 3, 9, and 15 are allowable because the Examiner has failed to make a *prima facie* case of obviousness since the Examiner has failed to show some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references. See *In re Fine,* 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir, 1988). All the Examiner has shown is that certain elements of the combination can be found in the prior art. Identification in the prior art of each individual part of the combination is insufficient to defeat patentability of the whole claimed

invention. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998).

These claims are also allowable because neither the Baker nor Matsumoto et al. reference cures the deficiencies of Hull et al.

Claims 7, 13, and 19 each state that the slider moves along the shaft of the tool and that the gripping section extends transverse to said direction. Clearly, in Hull, the gripping section is parallel to the direction of movement of the slider along the shaft. The Examiner in making the final rejection of this claim never discusses what in either Baker or Matsumoto would teach orienting a rotating handle so that a gripping section extends transverse to the direction of movement of a slider along a shaft. The fact of the matter is that neither secondary reference could teach or suggest or motivate one of ordinary skill in the art to arrive at the claimed subject matter because neither reference has a slider or a handle attached to a slider. The handle in Baker is mounted to a stationary cylinder and the handle in Matsumoto is attached to a motor body. Thus, it is submitted that the Examiner has failed to make a *prima facie* case of obviousness with respect to any of claims 7, 13 and 19.

(j) *Patentability of Independent Claim 20 Over the Combination of Hull et al. and Baker or Matsumoto*

Independent claim 20 is directed to an ergonomic tool comprising a shaft, a stop on the shaft, a slider movable on the shaft in a direction for striking the stop, and a handle on the slider to allow a user to move the slider. The handle has a

first leg rotatably connected to a first side of the slider and a second leg rotatably connected to a second side of the slider, and a central section forming a gripping section extending transverse to the direction. The central section extends between and is joined to the first and second legs. The handle moves relative to the slider along an axis parallel to the longitudinal axis as the user moves the slider towards and away from the stop.

The Hull et al. patent clearly lacks certain of the claimed features. For example, it lacks a handle having two legs rotatably connected to different sides of the slider. It also lacks a central section which forms a gripping section that extends transverse to the direction of movement of the slider. Still further, it lacks any handle which moves relative to the slider along an axis parallel to a longitudinal axis of the slider as the user moves the slider towards and away from the stop.

The Examiner takes the position that Baker and Matsumoto each show a rotatable handle and that therefore, it would be obvious to replace the handles in Hull et al. by a rotatable handle. The rejection fails for the following reasons.

The Baker patent is directed to an access tool which is smashed against a door or the like. It lacks any slider mounted on a shaft and a rotatable handle mounted to the slider. The only rotatable handle disclosed in the Baker patent is the hoist handle (20) which is attached to an outer surface (15) of an outer cylinder (11) by a bolt-nut combination. Certainly, there is nothing in Baker which would teach or suggest that one could facilitate the movement of a slider on a shaft by using a rotatable handle since there is no slider in Baker. In fact, one of ordinary skill in the art would be dissuaded from using the

handle in Baker because the handle is mounted on a bolt (21) which passes through the cylinder (11). One could not use such an arrangement in the Hull et al. device because a bolt passing through the slider would preclude and impair movement of the slider relative to the shaft. Thus, one of ordinary skill in the art would not be motivated to make the combination. See *In re Gordon,* 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The Matsumoto patent is from non-analogous art. The Matsumoto patent relates to a portable manually operated apparatus for cutting turf which has two control handles (19) fixed to a motor body by handle fixing knobs (20). Each handle is separately adjustable. A balance band (21) is provided to enable the operator to maintain the balance of the machine. The vibrating cutting-machine of this invention is used by holding the cutting handles (19), standing the main body (1) perpendicularly on the field of a golf course and placing the lower edge (16a) of the cutting depth adjusting member (16) on the turf (13) to be cut. Clearly, there is no slider in Matsumoto whose movement is caused by the handles (19). Appellant submits that because of the diverse nature of Matsumoto et al., it would not suggest, teach or motivate one of ordinary skill in the art to replace the fixed handles on the slider of Hull et al. by the rotatable handles of Matsumoto.

Further, neither Baker nor Matsumoto teaches or suggests providing a gripping section which extends transverse to the direction of movement of the slider since there is no slider in either Baker or Matsumoto.

Still further, neither Baker nor Matsumoto teaches or suggests placing a handle so that it moves relative to a slider along an axis parallel to the longitudinal axis of the slider because neither reference has a slider.

It is submitted that one of ordinary skill in the art would not be motivated to combine the references in the manner suggested by the Examiner. It is further submitted that the Examiner has failed to make a *prima facie* case of obviousness against claim 20 and that this rejection should be reversed.

(k) *Patentability of Independent Claims 8, 14 and 20 Over the Combination of Cloud in view of Baker or Matsumoto et al.*

The subject matter of claims 8, 14, and 20 have previously been discussed in this Brief and are incorporated by reference herein.

The Cloud patent is directed to a fifth wheel pin removal system. FIGS. 4 and 5 in the patent illustrate the Cloud invention which comprises a pin assembly (70) and a hammer assembly (72). The hammer assembly comprises a rod (110) having a first end and a second end (114). A coupling (116) is attached to the rod (110) at the first end and a stop (116) is attached to the second end (114). A weight (118) is mounted onto the rod (110) and slides from the first end to the second end. Attached to the weight is a chain (120) with a handle (122). Using the handle, the weight can be slung against the stop to produce an impulsive force transferred by rod (110) to coupling (116) and thus to pin assembly (70). The chain is provided so that the hammer assembly operates with the user's hands clear of the fifth wheel.

With respect to claim 8, Cloud lacks a handle attached to the slider that is movable relative to the slider from a first position in proximity to the first end to a second position in proximity to the second end when the slider strikes the stop.

Cloud also lacks a handle having a first leg joined to the slider, a second leg joined to the slider, and a central section extending between and joined to the first and second legs.

With respect to claim 14, Cloud lacks the handle formed by a first leg joined to a first side of the sleeve, a second leg joined to a second side of the sleeve, and a central section extending between and being joined to the first and second legs.

With respect to claim 20, Cloud lacks the handle having a first leg rotatably connected to a first side of the slider, a second leg rotatably connected to a second side of the slider, and a central section forming a gripping section extending transverse to the direction of movement of the slider. Nor does Cloud have a handle which moves relative to the slider along an axis parallel to the longitudinal axis as the user moves the slider towards and away from the stop.

The Examiner attempts to cure these deficiencies through the Baker or Matsumoto et al. patents. The Examiner fails to recognize in applying these references that there is a reason why the chain is used - namely to keep the user's hands away from the fifth wheel. Given this need, one of ordinary skill in the art is not going to be inclined to replace the handle in Cloud by a handle that is directly affixed to the weight because such a handle is not going to keep the user's hands away from the fifth wheel when the handle is being used to move the weight.

Further, the Baker patent is directed to an access tool which is smashed against a door or the like. It lacks any slider mounted on a shaft and a rotatable handle mounted to the slider. The only rotatable handle disclosed in the Baker patent is the hoist handle (20) which is attached to an outer surface (15) of an outer cylinder (11) by a bolt-nut combination. Certainly,

there is nothing in Baker which would teach or suggest that one could facilitate the movement of a slider on a shaft by using a rotatable handle since there is no slider in Baker. In fact, one of ordinary skill in the art would be dissuaded from using the handle in Baker because the handle is mounted on a bolt (21) which passes through the cylinder (11). One could not use such an arrangement in the Cloud device because a bolt passing through the slider would preclude and impair movement of the slider relative to the shaft. Thus, one of ordinary skill in the art would not be motivated to make the combination. See *In re Gordon,* 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The Matsumoto patent is from non-analogous art. The Matsumoto patent relates to a portable manually operated apparatus for cutting turf which has two control handles (19) fixed to a motor body by handle fixing knobs (20). Each handle is separately adjustable. A balance band (21) is provided to enable the operator to maintain the balance of the machine. The vibrating cutting-machine of this invention is used by holding the cutting handles (19), standing the main body (1) perpendicularly on the field of a golf course and placing the lower edge (16a) of the cutting depth adjusting member (16) on the turf (13) to be cut. Clearly, there is no slider in Matsumoto whose movement is caused by the handles (19). Appellant submits that because of the diverse nature of Matsumoto et al., it would not suggest, teach or motivate one of ordinary skill in the art to replace the fixed handles on the slider of Cloud by the rotatable handles of Matsumoto.

Further, neither Baker nor Matsumoto teaches or suggests providing a gripping section which extends transverse to the direction of movement of the slider since there is no slider in either Baker or Matsumoto.

Still further, neither Baker nor Matsumoto teaches or suggests placing a handle so that it moves relative to a slider along an axis parallel to the longitudinal axis of the slider because neither reference has a slider.

It is submitted that one of ordinary skill in the art would not be motivated to combine the references in the manner suggested by the Examiner. It is further submitted that the Examiner has failed to make a *prima facie* case of obviousness against independent claims 8, 14, and 20 and that this rejection should be reversed.

(1) *Patentability of claims 9, 13, 15, 17 - 19 over Cloud in view of Baker or Matsumoto*

Claims 9 and 15 each call for the handle to be rotatably attached to the slider. Clearly, in Cloud, the handle is not rotatably attached to the slider. Recognizing this deficiency, the Examiner cites Baker and Matsumoto et al. as disclosing an impact tool comprising a handle including leg portions and a gripping portion rotatable relative to a body or slider during tool impact, wherein the gripping portion is transverse to a longitudinal axis of the body or slider. The Examiner concludes that it would have been obvious to one skilled in the art to provide Cloud with a movable handle which rotates and is oriented as claimed in order to allow for an alternate handle grasping orientation and since to do [so] provides no new and unexpected results.

The proposed combination of references fails for the following reasons. In the claimed invention, the rotatable handle is needed to facilitate the pulling of the slider between its end positions. Cloud accomplishes the same exact result

using a handle attached to a chain. The question then becomes what would motivate one of ordinary skill in the art to substitute a rotatable handle in lieu of Cloud's handle and chain arrangement. Certainly, there is nothing in the Baker or Matsumoto et al. patents which would motivate such a modification.

The Baker patent is directed to an access tool which is smashed against a door or the like. It lacks any slider mounted on a shaft and a rotatable handle mounted to the slider. The only rotatable handle disclosed in the Baker patent is the hoist handle (20) which is attached to an outer surface (15) of an outer cylinder (11) by a bolt-nut combination. Certainly, there is nothing in Baker which would teach or suggest that one could facilitate the movement of a slider on a shaft by using a rotatable handle since there is no slider in Baker. In fact, one of ordinary skill in the art would be dissuaded from using the handle in Baker because the handle is mounted on a bolt (21) which passes through the cylinder (11). One could not use such an arrangement in the Cloud device because a bolt passing through the slider would preclude and impair movement of the slider relative to the shaft. Thus, one of ordinary skill in the art would not be motivated to make the combination. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The Matsumoto patent is from non-analogous art. The Matsumoto patent relates to a portable manually operated apparatus for cutting turf which has two control handles (19) fixed to a motor body by handle fixing knobs (20). Each handle is separately adjustable. A balance band (21) is provided to enable the operator to maintain the balance of the machine. The vibrating cutting-machine of this invention is used by holding the cutting handles (19), standing the main body (1)

perpendicularly on the field of a golf course and placing the lower edge (16a) of the cutting depth adjusting member (16) on the turf (13) to be cut. Clearly, there is no slider in Matsumoto whose movement is caused by the handles (19). Appellant submits that because of the diverse nature of Matsumoto et al., it would not suggest, teach or motivate one of ordinary skill in the art to replace the chain and handle of Cloud by the rotatable handles of Matsumoto.

It is submitted that claims 9 and 15 are allowable because the Examiner has failed to make a *prima facie* case of obviousness since the Examiner has failed to show some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references. See *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir, 1988). All the Examiner has shown is that certain elements of the combination can be found in the prior art. Identification in the prior art of each individual part of the combination is insufficient to defeat patentability of the whole claimed invention. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998).

These claims are also allowable because neither the Baker nor Matsumoto et al. reference cures the aforenoted deficiencies of Cloud.

Claims 13 and 19 each state that the slider moves along the shaft of the tool and that the gripping section extends transverse to said direction. Cloud is totally silent on the orientation of the handle relative to the direction of movement of the slider. The Examiner in making the final rejection of this claim never discusses what in either Baker or Matsumoto would teach orienting a rotating handle so that a gripping

section extends transverse to the direction of movement of a slider along a shaft. The fact of the matter is that neither secondary reference could teach or suggest or motivate one of ordinary skill in the art to arrive at the claimed subject matter because neither reference has a slider or a handle attached to a slider. The handle in Baker is mounted to a stationary cylinder and the handle in Matsumoto is attached to a motor body. Thus, it is submitted that the Examiner has failed to make a *prima facie* case of obviousness with respect to any of claims 13 and 19.

Claim 16 has been cancelled and therefore the rejection of this claim is moot.

Claims 17 and 18 are allowable for the same reasons as their parent claims.

CONCLUSION

For the foregoing reasons, the Board is hereby requested to reverse the rejections of claims 1 - 3, 5 - 9, 11 - 15 and 17 - 20 and remand the application to the Primary Examiner for allowance and issuance.

FEES

The Director is hereby authorized to charge the Appeal Brief fee of $500.00 to Deposit Account No. 21 - 0279. Should

the Director determine that an additional fee is due, he is hereby authorized to charge said fee to said Deposit Account.

Respectfully submitted,

Leonard M. Walsh

IN TRIPLICATE

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Date: March 17, 2006

I, Nicole Motzer, hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313" on **March 17, 2006**.

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APPENDIX A - CLAIMS ON APPEAL

1. An impact tool, comprising:

a shaft;

a stop on said shaft;

a slider movable on said shaft for striking said stop to create an impact force;

a handle on said slider to allow a user to move said slider;

said handle comprising two legs extending from said slider and a central section extending between and joined to said legs;

a first one of said legs being connected to a first side of said slider and a second one of said legs being connected to a second side of said slider; and

wherein said handle moves relative to said slider when said slider strikes said stop to isolate said handle from said impact force.

2. The impact tool as recited in claim 1, wherein said handle is movably attached to said slider.

3. The impact tool as recited in claim 2, wherein said handle is rotatably attached to said slider.

5. The impact tool as recited in claim 1, wherein the user can grasp said handle with the wrist in the normal position.

6. The impact tool as recited in claim 5, wherein said handle forms a gripping section located a distance away from said slider.

7. The impact tool as recited in claim 6, wherein said slider moves along said shaft in a direction, and said gripping section extends transverse to said direction.

8. An impact tool, comprising:

a shaft;

a stop on said shaft;

a slider movable on said shaft for striking said stop to create an impact force, said slider having a first end and a second end;

a handle movably attached to said slider to allow a user to move said slider and said handle being moveable relative to said slider from a first position in proximity to said first end to a second position in proximity to said second end when said slider strikes said stop; and

said handle having a first leg joined to said slider, a second leg joined to said slider, and a central section extending between and joined to said first and second legs.

9. The impact tool as recited in claim 8, wherein said handle is rotatably attached to said slider.

11. The impact tool as recited in claim 8, wherein the user can grasp said handle with the wrist in a normal position.

12. The impact tool as recited in claim 11, wherein said handle forms a gripping section located a distance away from said slider.

13. The impact tool as recited in claim 12, wherein said slider moves along said shaft in a direction and said gripping means extends transverse to said direction.

14. A slider for an impact tool, comprising:

a sleeve; and

a handle movably attached to said sleeve to allow a user to move said slider, said handle being formed by a first leg joined to a first side of said sleeve, a second leg joined to a second side of said sleeve, and a central section extending between and being joined to said first and second legs;

wherein said handle moves relative to said slider in a direction parallel to a longitudinal axis of said sleeve when said slider strikes a stop on said impact tool to isolate said handle from a force created by said slider striking said stop.

15. The slider as recited in claim 14, wherein said handle is rotatably attached to said sleeve.

17. The slider as recited in claim 14, wherein the user can grasp said handle with the wrist in a normal position.

18. The slider as recited in claim 14, wherein said handle forms a gripping section located a distance away from said slider.

19. The slider as recited in claim 18, wherein said impact tool has a shaft, said slider is adapted to move along said shaft in a direction, and said gripping section extends transverse to said direction.

20. An ergonomic tool, comprising:

a shaft;

a stop on said shaft;

a slider movable on said shaft in a direction for striking said stop to create an impact force, said slider having a first end and a second end and a longitudinal axis;

a handle on said slider to allow a user to move said slider, said handle having a first leg rotatably connected to a first side of said slider, a second leg rotatably connected to a second side of said slider, and a central section forming a gripping section extending transverse to said direction;

said central section extending between and being joined to said first and second legs; and

wherein said handle moves relative to said slider along an axis parallel to said longitudinal axis as the user moves said slider towards and away from said stop; and

wherein said user can grasp said handle with the wrist in a normal position.

APPENDIX B - EVIDENCE

NOT APPLICABLE

APPENDIX C - RELATED PROCEEDINGS

NOT APPLICABLE